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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,258	08/27/2003	David S. Benco	27-20-20-21-20	7204

7590
Lucent Technologies Inc.
Docket Administrator
(Room 3J-219)
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

06/15/2007

EXAMINER

NGUYEN, TU X

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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06/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,258

Applicant(s)

BENCO ET AL.

Examiner

Tu X. Nguyen

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments, dated 5/22/07, with respect to claims 1 and 8 have been considered but are not persuasive.

In response to Applicant argument "Claims 1 and 8 were amended in the RCE filed 21 December 2006 to more clearly recite a user-initiated request for call transfer, i.e., one that is affirmatively requested by a human operator of a first communication unit, For example, as stated in page 5, lines 28-31 of applicant's specification, a mobile party may invoke a transfer request by entering a code (e.g., "88), pressing a button, using a point-and click method or generally any appropriate user interface available to the mobile party. These amendments are believed to clearly distinguish over the Huomo publication", the examiner respectfully disagrees; Huomo et al. disclose "Optionally, the invention may provide forward the user of telephone 26 to be given a choice of whether he wishes to be kept on hold, or immediately transferred to" (par.032, "a choice of immediately transfer" reads on "user-initiated request"); it is noted that the features upon which applicant relies (i.e., "a mobile party may invoke a transfer request by entering a code (e.g., "88), pressing a button, using a point-and click method") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicants argument "Further, to the extent the Office Action suggests that the user-initiated request for call transfer may be disclosed at paragraph [0032], the

applicant respectfully disagrees. Paragraph [0031] describes that in the event that a call is placed on hold to allow for battery replacement of a cell phone 12, an announcement is played to the second party, telephone 26 to inform the second party that the call has been placed on hold. Paragraph [0032] describes an option whereby the second party user of telephone 26 is given a choice of remaining on hold or to be immediately transferred to an alternate connection. It is noted, no matter what choice the second party makes, the choice is prompted by the MSC (i.e., upon the condition of system-initiated hold period to a low battery condition in a first party cell phone. There is no teaching or suggestion that the second party, or the first party, may initiate transfer while engaged in .an active call, as claimed", the examiner respectfully disagrees, paragraph 029 describes "in one embodiment of the invention,if the user of cellular telephone 12 is a salesman of a particular company, and the user of telephone 26 is a customer, it may be desirable to hand over the call to another salesman of that same company to continue the sales call"; wherein the telephone 26 corresponds to "a party engaged in an active call", following a choice of transfer a call to other party, switch 34 will then follow the direction given to hand over.....(see, par.033).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-9 and 11-12, are rejected under 35 U.S.C. 102(e) as being anticipated by Huomo et al. (US Pub. 2003/0022671).

Regarding claim 1, Huomo et al. disclose a method comprising a switching element performing the steps of:

receiving, from a party engaged in an active call, a user initiated request for transfer of the call from a first communication unit to a pre-provisioned second communication unit associated with the party (see par.032);

responsive to the request, consulting a database to determine the second communication unit (see par.021, 0027);

while maintaining a telephonic connection (see par.024) to the first communication unit, attempting to establish a telephonic connection to the second communication unit (see par.0032);

if the connection to the second communication unit is established, dropping the connection to the first communication unit, thereby transferring the call from the first communication unit to the second communication unit of the party (see par.024).

Regarding claims 2 and 11, Huomo et al. disclose the step of receiving a request for transfer (see par.012, the cellular telephone sends a signal to a mobile switching center" corresponds to "receiving a request") is accomplished without receiving a directory number of the second communication unit (see par.012, the switching is done automatically without a specified destination address information from the communication unit).

Regarding claims 3 and 9, Huomo et al. disclose the first communication unit comprises a mobile phone and the second communication unit comprises a landline phone associated with the party (see par.002).

Regarding claim 5, Huomo et al. disclose if the connection to the second communication unit is not established sending a message to the first communication unit indicating that the requested transfer did not occur (see par.031).

Regarding claim 6, Huomo et al. disclose the step of consulting a database comprises resulting the database to determining a directory number of the second communication unit (see par.021, 027).

Regarding claim 7 is rejected with similar reasons set forth for claims 5 and 6.

Regarding claim 8, Huomo et al. disclose a method comprising a switching element performing of:

receiving, from a first communication unit, a user initiated call transfer request (see par.032);

responsive to the call transfer request, consulting a database including indicia of the first communication unit and indicia of a second communication unit to which call transfer may be directed from the communication unit, the switching element identifying the second communication unit coincident to consulting the database (see par.021, 027); and

transferring the call from the first communication unit to the second communication unit (see par012).

Regarding claim 12, Huomo et al. disclose the step of transferring the call comprises: while maintaining a telephonic connection to the first communication unit, establishing a

telephonic connection to the second communication unit (see par.024); after the connection to the second communication unit is established, dropping the connection to the first communication unit (see par.024).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huomo et al. (US Pub. 2003/0022671).

Regarding claims 4 and 10, Huomo et al. disclose the first communication unit comprises a mobile phone and the second communication unit comprises a landline phone of the party (see par.002). Huomo et al. fail to disclose the first communication unit comprises a landline phone and the second communication unit comprises a mobile phone. However, the call transfer method is switched connection automatically, at the network level by a mobile switching center and optionally respond for switching by pushing button may be on a landline phone (see par.012, 032). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Huomo et al. to provide a call transfer from a mobile to a landline phone or vice versa without a required call transfer feature in a landline phone.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is 571-272-7883.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



June 07, 2007



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